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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,994	09/08/2003	Michael W. McCarty	06005/37296	2276
4743	7590	07/12/2005	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			BASTIANELLI, JOHN	
			ART UNIT	PAPER NUMBER
			3751	

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

	Application No.	Applicant(s)
	10/657,994	MCCARTY ET AL.
	Examiner	Art Unit
	John Bastianelli	3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 18 April 2005.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-21 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-21 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 08 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 1/20/04.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. The restriction has been waived for now although the examiner reserves the right to restrict at a later date if deemed necessary.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-11, 13-15, 17, and 19-21 are rejected under 35 U.S.C. 102(b) as anticipated by Roth et al. DE 199 60 330 A1 (US 6,361,018 used for translation).

Roth discloses a sleeve valve having a valve body 11, a flow passage through the valve body, the passage having a longitudinal axis; a slidable sleeve 12 received in the flow passage and movable in an axial direction between an opened and a closed position; a valve plug 13 positioned within the flow passage and arranged to cooperate with the slidable sleeve to open or close the sleeve valve; and a first end portion of the valve plug having an upstream flow directing surface (towards inlet E), the first end portion being removably mounted to a part of the valve plug within the flow passage and being replaceable with at least a second end portion removably mountable to the part of the valve plug to change at least one performance or flow characteristic of the sleeve valve. The terms “being replaceable”, “can be changed”, “being removably attachable”, etc. are suggested use and is not given patentable weight. Inherently, the

bolt allows for the first end to be removed therefore may be removed therefore meets the limitation of the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113). The claims are product by process and only the final product need to be shown. A valve pressure recovery performance characteristic is therefore changed. The valve plug has a body fixed in position with the end portion removable. There are a plurality of end portions with each end portion has a different size or shape with different contours. The end portions have different contoured end flanges. The flow passage is cylindrical and slidable sleeve is circular. The end portions are removably installed with a discrete threaded fastener. The method is seen as practiced by the apparatus.

4. Claims 1-6 and 8-21 are rejected under 35 U.S.C. 102(b) as anticipated by Hettinger US 6,116,571.

Hettinger discloses a sleeve valve (Fig. 2) having a valve body 2; a flow passage 3 through the valve body, the passage having a longitudinal axis; a slidable sleeve 19 received in the flow passage and movable in an axial direction between an opened and a closed position; a valve plug positioned within the flow passage and arranged to cooperate with the slidable sleeve to open or close the sleeve valve; and a first end portion of the valve plug having an upstream flow directing surface (seen as towards pipe section 5 as the flow may be either way), the first end portion being removably mounted to a part of the valve plug within the flow passage and being replaceable with at least a second end portion removably mountable to the part of the valve plug to change at least one performance or flow characteristic of the sleeve valve. The terms "being

“replaceable”, “can be changed”, “being removably attachable”, etc. are suggested use and is not given patentable weight. Inherently, the bolt allows for the first end to be removed therefore may be removed therefore meets the limitation of the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113). The claims are product by process and only the final product need to be shown. A valve pressure recovery performance characteristic is changed. The valve plug has a body fixed in position with the end portion removable. There are a plurality of end portions with each end portion has a different size or shape with different contours. The flow passage is cylindrical and slidable sleeve is circular. The end portions are removably installed with a discrete threaded fastener. The threaded stem extends from the downstream end. The method is seen as practiced by the apparatus.

#### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Alternatively, claims 1-11, 13-15, 17, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al. DE 199 60 330 A1 (US 6,361,018 used for translation) in view of Green US 2,454,160.

Roth lacks disclosing that a second end portion is available. Green discloses using a plurality of different valve seats 20, 70, 75, and 93 that changes a performance or flow characteristic of the valve. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a plurality of end portions as disclosed by Green in order to changes a performance or flow characteristic of the valve of Roth in order to provide more options with a single valve.

7. Alternatively, claims 1-6 and 8-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hettinger US 6,116,571 in view of Green US 2,454,160. Hettinger lacks disclosing that a second end portion is available. Green discloses using a plurality of different valve seats 20, 70, 75, and 93 that changes a performance or flow characteristic of the valve. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a plurality of end portions as disclosed by Green in order to changes a performance or flow characteristic of the valve of Hettinger in order to provide more options with a single valve.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Samuel, Max, Robinson, Orlandi, Bircann, Pickering, and Brestel disclose removable and replaceable valves.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Bastianelli whose telephone number is (571) 272-4921. The examiner can normally be reached on M-F (9:00-6:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John Bastianelli  
Primary Examiner  
Art Unit 3751



JB  
July 9, 2005